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EXAMINER
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LAUX, JESSICA L

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3635

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/2011 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Applicant's remarks appear to be drawn only to limitations newly added to the claims, which are addressed in the new rejection below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation "the layer" at lines 3-4, however there is lack of antecedent basis for "the layer". It is unclear to which layer

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“the layer” is referring. For the purposes of examination, as best understood, the claim will be examined as if “the layer” is the intermediate layer.

Claims 11,12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites “are connector devices for tongue and groove joints” however it is unclear and ambiguous of the claim is actually claiming a tongue and a groove or just connectors used on boards having tongue and groove joints, separate from the tongue and groove. For the purposes of examination, based on the specification and drawings, it will be understood that the claimed connector devices are the tongue and groove, however appropriate correction/clarification is required.

Claim 12 depends from claim 11 which recites connector devices of tongue and groove, however claim 12 then recites “a tongue” and “a groove”. It is unclear if the tongue and groove of claim 12 are the same as or different than the connector devices (as above) of claim 11.

Claim 10 recites the limitation “the elements for forming the devices for connection” in line 2. There is insufficient antecedent basis for the limitation “the elements for forming” in the claim.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the above rejection for claim 10 it is unclear

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whether the engaging connector devices are "the elements for forming" or if they are "the devices for connection" or if they are all together a completely different element.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 recites the limitation "the tongue and groove" in line 2. There is insufficient antecedent basis for this limitation in the claim. Additionally claim 10 recites "the elements" which lacks antecedent basis as noted above, and claim 16 which depends therefrom recites "an element". It is unclear if this is the same as or different than the elements of claim 10 and how the tongue and groove elements of claim 16 are incorporated into "the elements for forming the devices for connection" of claim 10 (i.e. are they the same as or different from each other and if different how are the tongue and groove and devices for connection incorporated on the same board?).

Claims 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20-21 ultimately depend from claim 1 which recites "devices for connecting the building component to other such building components" and claims 20-21 recites that the building system encompasses elastic joint connection elements for the connection of building components. It is unclear if these elastic joint connection elements are the same as or different than the devices for connecting the building component as in claim 1. If they are the same as, there should be proper antecedent basis and correlation between the elements. If they are different,

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it is unclear how there are both devices for connecting the building components and elastic joint connection elements for connection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1,4,6-7,9-17,19-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Pervan et al (WO03078761).**

Claims 1,4, 19-21. Pervan et al disclose a building component for forming floor and/or wall coverings, comprising:

a support layer (32) for placement on a floor or a wall to be covered;

an upper layer (31) supported by the support layer and including at least one coating element forming a visible upper surface of the building component;

an intermediate layer (either 36a or 30) arranged between and connecting the support layer and the upper layer;

elastic devices for connecting (8,9,10,12) the building component to other such building components applied to the floor or a wall; and

a bordering (either 36a,20,21 as seen in figures 6a,b; or 80,81,20,21 as seen in figure 6c) encircling an entire periphery of the building component (as seen in figure 7a) and forming a visible filling at the visible upper surface of joints between coating elements of the upper layers of the building component and adjacent other such

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building components connected to the building component by said devices (as seen in figures 6-7).

It should be noted that the limitations “wherein the intermediate layer and the bordering are simultaneously formed in one piece in a molding cavity of a tool by foaming or spraying onto the support layer and the at least one coating element” and “the intermediate layer is foamed or sprayed” are considered a product-by-process limitation. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

Claim 6. The building component according to claim 1, wherein the width of the bordering encircling the building component is half as wide as the width of joints between several coating elements (as seen in figures 6-7; page 21, lines 6-15).

Claim 7. The building component according to claim 1, wherein the intermediate layer is made of an elastic and/or water-resistant material (where pages 19-20 disclose different elastic or water-resistant materials for the seals 36 or 80,81).

Claim 9. The building component according to claim 1, wherein the coating element is made of ceramic, stoneware, natural stone, glass, plastic, metal and/or wood (as disclosed throughout the disclosure the coating element is made of a plastic with metal – aluminum oxide).

Claim 10. The building component according to claim 1, wherein the elements for forming the devices for connection of the building components are molded together to the intermediate layer in one piece and/or the intermediate layer is foamed or sprayed on separate similar elements (as seen in the figures and noted in the disclosure element 36 is together with the intermediate layer in one piece and elements 80,81 are disposed on separate similar elements).

It should be noted that claim 10 contains a product-by-process limitation (where “the building components are molded together” and “... is foamed or sprayed” are process limitations). The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

Claim 11. The building component according to claim 1 wherein the devices for connecting are connector devices for tongue-and-groove joints (as seen in the figures and noted throughout the disclosure).

Claim 12. The building component according to claim 11, wherein a groove is formed at two sides which are perpendicular relative to each other and a tongue is formed at the sides opposing these sides (as seen in figure 7a).

Claim 13. The building component according to claim 10, wherein engaging connector devices are provided (12,8).



Claim 14. The building component according to claim 11, wherein the groove is formed between the support layer and the upper layer encompassing the coating element (as seen figures 6-7).

Claim 15. The building component according to claim 10, wherein the edges of the support layer and of the upper layer encompassing the coating element are arranged offset relative to each other, parallel to the plane of the support layer (as seen in figures 6-7 the edges of the upper layer are offset from the edges of the support layer).

Claim 16. The building component according to claim 10, wherein an element having the tongue or groove (9,10) is connected in one piece with the intermediate layer.

Claim 17as best understood. The building component according to claim 1, wherein the support layer has a surface profile and/or a soft, ductile coating on its side facing away from the (intermediate?) layer which is connected to the support layer (where the support layer has a surface profile).

Claim 22. The building component according to claim 1, wherein the building component is curved as a whole and/or exhibits a curved surface (where page 11, at lines 35-37 discloses that the floorboard can exhibit a wave, or curved, shape).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Pervan et al (WO03078761) in view of Miller et al (20040031226).**

Claim 8. Pervan discloses the building component according to claim 1 but does not expressly disclose that the support layer is made of recycling material. However, at pages 3-5 Pervan discloses that various suitable materials may be utilized in manufacturing the device, depending on the particular attributes desired. Further, it is common and well known in the flooring art to make support/backing layers of recycled materials. For example Miller discloses a floorboard having a backing layer 16 made of recycled materials (paragraph 0021). Therefore in view of the prior art it would have been obvious to one of ordinary skill in the art to modify the backing layer of Pervan to be made of recycled materials to be more environmentally conscious and appeal to a "green" or eco friendly/minded consumer.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Pervan et al (WO03078761) in view of Milborn (2548036).**

Claim 18. Pervan et al discloses the building component according to claim 1, but does not disclose pipes for a heating and/or cooling, heating conductors and/or sensors are embedded in the building component in the support layer. Milborn discloses a panel for use in flooring having layers and pipes disposed in a support layer for heating a floor made of the panels (see figures; disclosure). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the panel of Pervan et al. to have the pipes as disclosed by Milborn to incorporate heating/cooling into the

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building component to provide efficient and space-saving thermal elements to a building.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jessica Laux/  
Examiner, Art Unit 3635

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